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Therefore, Applicant requests that the Examiner enter this reference with a date of 1998 for purposes of examination. As a convenience, Applicant has attached another copy of the reference in question to the end of this Office Action Response. Applicant requests that the Examiner review the reference as it pertains to the claimed invention, and indicate such consideration of the reference in the appropriate place on the IDS.

#### Claim Rejections Under 35 USC 102

Claims 1, 2, 4-10, 13, 15-19, 22, and 23 have been rejected under 35 USC 102(b) as being anticipated by Mattaway (6,131,121). Applicant vigorously but respectfully submits that these claims are not anticipated by Mattaway. Furthermore, Applicant respectfully asserts that the Examiner's position as to these claims being anticipated by Mattaway would not stand on appeal. Applicant now discusses each of the claims rejected under 35 USC 102 in order.

#### *Rejection of Claim 1 Under 35 USC 102*

Claim 1 is an independent claim including a network, a first client, and a second client. Importantly, the first client has "a first email messaging program installed thereon *on which a composing user composes a message and records media*, the first email messaging program sending the message to a receiving user over the network". (Emphasis added) Similarly, the second client has "a second email messaging program installed thereon on which the receiving user receives the message over the network, *the second email messaging program playing back the media upon the user viewing the message*". (Emphasis added) Applicant submits that Mattaway does not disclose at least the emphasized limitations of claim 1.

Applicant submits that Mattaway does not disclose the limitation of a first email messaging program "on which a composing user composes a message and records media," nor the limitation of "the second email messaging program playing back the media upon the user viewing the message", such that Mattaway does not anticipate the invention of claim 1. Mattaway's first

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embodiment, which is described beginning at column 6, line 60, utilizes email addresses as a way to identify users with whom real-time, point-to-point communications can be subsequently arranged. “[T]he first user may directly enter the E-mail address of the callee.” (Col. 7, ll. 23-24) “The connection server 26 then searches the database 34 to determine whether the callee is logged-in by finding any stored information corresponding to the callee’s E-mail address indicating that the callee is active and on-line.” (Col. 7, ll. 24-29) Assuming that the callee is online, the caller’s client “may then directly establish the point-to-point Internet communications with the callee using the IP address of the callee.” (Col. 7, ll. 35-36)

As such, Mattaway’s first embodiment does not utilize an email messaging program for a composing user to compose a message and record media and another email messaging program for a receiving user to play back the media, as to which claim 1 is limited. The only connection with email that Mattaway’s first embodiment has is that the composing user can utilize the receiving user’s email address as an identifier to locate the receiving user and determine whether the receiving user is online. If the receiving user is online, a direct point-to-point Internet communication is then established from the sending user to the receiving user, over which media may be exchanged. Mattaway’s first embodiment does not utilize an email messaging program to compose a message and record media or to playback the media. An email messaging program is not used in Mattaway’s first embodiment, but rather only the email addresses of potential callees are employed as unique identifiers of the callees.

Furthermore, Mattaway’s second embodiment, which is described beginning at column 7, line 54, has a caller’s client sending a callee’s client an email in which a connection request message is included. (Col. 7, l. 62, through col. 8, l. 32) Once the callee receives the email,

[p]oint-to-point communication may then be established by the processing unit 22 processing the E-mail signal to extract the <ConnectRequest> message, including the IP address of the first processing unit 12 and the session number. The second processing unit 22 may then open a socket and . . . send[] the <ConnectOK> signal

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directly over the Internet 24 to the IP address of the first processing unit 12 *without processing by the mail server 28.*

(Col. 9, ll. 5-16) (Emphasis added)

As such, Mattaway's second embodiment also does not utilize an email messaging program for a composing user to compose a message and record media or an email messaging program for a receiving user to receive the message and playback the media, as to which claim 1 is limited. Mattaway's second embodiment utilizes an email message sent from the composing user's computer (or computing device) to the receiving user's computer (or computing device) only to send communication information from the former computer to the latter computer. The latter computer uses this information to set up a point-to-point Internet communication, in which media may then be exchanged. The media is not recorded within an email messaging program in Mattaway's second embodiment, nor is the media played back within the email messaging program. An email messaging program is used in Mattaway's second embodiment only to exchange communication information so that a subsequent point-to-point communication session can then be established.

Applicant believes that the Examiner may have mistaken Mattaway's point-to-point communication teachings with the email-based invention of claim 1. Email is known to be a non-real-time, asynchronous form of communication, similar to voicemail. With voicemail, a person leaves a voicemail message, and it is heard by the recipient at a later time. With email, a composing user composes and sends an email through an email messaging program from his or her mail server, through the Internet, to a receiving user's mail server. At some point later in time, the receiving user retrieves the email from the receiving user's email server, using another email messaging program. The receiving user can then view the email sent by the composing user. This process is not accomplished in real-time – the receiving user cannot view the media substantially instantaneously with the creation of the media by the composing user. Email, as its name suggests, can be considered as electronic mail. The composing user writes a letter and

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drops it into the mail, or sends it through a mail server. At a later point in time, possibly even days or weeks later, the receiving user receives the letter and is able to read it.

By comparison, the point-to-point communication approach of Mattaway provides for “real-time . . . communications.” (Abstract) The composing user establishes a synchronous direct, or point-to-point, communication link with the receiving user. (Col. 3, ll. 15-20) Email is not used once the direct communication link has been established. In Mattaway’s first embodiment, email is not used, whereas in Mattaway’s second embodiment, email is used to exchange information so that the direct communication link can then be established. (Col. 12, ll. 41-43) A real-time point-to-point communication is known to be a synchronous form of communication, similar to a live telephone call. Like a phone call, in which both parties must be present to speak to each other, in a point-to-point communication both the caller and the callee must be online at the same time in order to communicate, and the communication is accomplished in real-time, with both parties speaking to one another.

#### *Rejection of Claim 2 Under 35 USC 102*

Claim 2 is a dependent claim depending from claim 1. As such, it is patentable for at least the reasons that have been described in accordance with claim 1. Claim 2 adds an element to the system of claim 1, a “streaming media server.” The first email messaging program “upload[s] the media to the streaming media server upon the message being sent to the receiving user over the network,” whereas the second email messaging program “download[s] the media from the streaming media server over the network upon the receiving user viewing the message.” That is, the media is uploaded to the streaming media server by the composing user’s email messaging program, and then downloaded from the streaming media server by the receiving user’s email messaging program when the receiving user views the message. Applicant submits that Mattaway does not disclose this added limitation of claim 2.

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The Examiner suggests that the streaming media server is the Internet 24 of FIG. 4 in Mattaway. However, the Internet is not a server. The Internet is a network, which is very different than a server. A server can be connected to a network, but is not the network. A composing user does not upload media to the Internet 24 for storage thereon and subsequent download by a receiving user. Rather, the composing user can upload media to a *streaming media server* connected to the Internet 24, for storage on the server and subsequent download by the receiving user. Therefore, Mattaway does not disclose a streaming media server, as to which claim 2 is limited.

Furthermore, the point-to-point nature from the composing user's computer to the sending user's computer of the disclosure of Mattaway means that a streaming media server is not part of Mattaway's system. A point-to-point connection is a direct connection between a first entity and a second entity, so that data, such as media, can be transmitted directly between the two entities. No storage occurs on the connection itself. Rather, in Mattaway "realtime audio and/or video conversations may be conducted," such that "the point-to-point communication link is established and audio or video signals are being transmitted." (Col. 10, ll. 5-13) Audio or video signals are thus transmitted *through* the communication link, and are not stored *by* the communication link, because a communication link is not a server. Mattaway does not disclose a streaming media server, as to which claim 2 is limited.

Applicant finally notes that the Examiner has indicated that the Internet 24 of FIG. 4 in Mattaway is the network element of claim 1. If it is the network element of claim 1, however, then the Internet 24 of FIG. 4 cannot also be the streaming media server element of claim 2. Mattaway does not anticipate the claimed invention of claim 2.

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*Rejection of Claims 4, 5, 6, and 7 Under 35 USC 102*

Claims 4, 5, 6, and 7 are dependent claims depending from independent claim 1. As such, they are patentable for at least the same reasons that have been described in relation to claim 1. Applicant therefore submits that these claims are also not anticipated by Mattaway.

*Rejection of Claim 8 Under 35 USC 102*

Claim 8 is an independent claim including a network mechanism and an email messaging program. Importantly, the email messaging program has at least “a composing capability for a user to compose a message and *record media associated with the message* to send to another user over the network via the networking mechanism.” (Emphasis added) Applicant submits that Mattaway does not disclose at least the emphasized limitation of claim 8.

Mattaway does not employ an email messaging program that has the capability to record media associated with a message that is sent to another user over a network, as has been discussed in association with claim 1. Mattaway’s first embodiment only utilizes email addresses to uniquely identify users with whom real-time, point-to-point communications can be subsequently arranged. An email messaging program having the capability to which claim 8 is limited is not disclosed by Mattaway in this respect. Mattaway’s second embodiment only utilizes email to exchange communication information needed to set up such real-time, point-to-point communications. An email messaging program is not disclosed in Mattaway that has the capability to record media associated with a message to be sent to another user over a network, as to which claim 8 is limited. Mattaway does not, therefore, anticipate claim 8.

*Rejection of Claim 10 Under 35 USC 102*

Claim 10 is a dependent claim depending from claim 8. As such, it is patentable for at least the reasons that have been described in accordance with claim 8. Claim 10 limits the composing capability of the email messaging program to “upload[ing] the media to a streaming

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media server communicatively coupled to the network over the network via the networking mechanism upon the message being sent to the other user over the network via the networking mechanism.” Applicant submits that Mattaway does not disclose this added limitation of claim 10.

Mattaway does not employ an email messaging program that uploads media to a streaming media server, as has been discussed in association with claim 2. The Examiner suggests that the processing of audio and video data streams over a network in Mattaway anticipates claim 10. However, Mattaway only discloses the sending of audio and video data streams from a caller to a callee directly through a point-to-point connection. Mattaway does not disclose the uploading of media to a streaming media server by an email messaging program. There is no streaming media server disclosed by Mattaway. Uploading media to a streaming media server inherently implies storage of the media on the server for subsequent downloading at a later time. By contrast, Mattaway’s real-time point-to-point connection does not store the media at any point along the connection for later download by the receiving user. Mattaway does not, therefore, anticipate claim 10.

#### *Rejection of Claim 12 Under 35 USC 102*

Claim 12 is a dependent claim depending from claim 8. As such, it is patentable for at least the reasons that have been described in accordance with claim 8. Claim 12 adds an additional limitation to the email messaging program of claim 8, such that the email messaging program also has “a playback capability for the user to view messages received from other users over the network via the networking mechanism and play back received media associated with the messages received.” Applicant submits that Mattaway does not disclose this added limitation of claim 12.

Mattaway does not employ an email messaging program that has the capability to play back media associated with a message that is received from another user over a network, as has

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been discussed in association with claim 1. As has been discussed in association with claim 8, Mattaway's first embodiment only utilizes email addresses to uniquely identify users to subsequently arrange real-time, point-to-point communications, and an email messaging program having media playback capability is not disclosed by Mattaway. Mattaway's second embodiment only utilizes email to exchange communication information needed to set up such real-time, point-to-point communications, and also does not disclose an email messaging program that has the capability to playback the media, as to which claim 12 is limited. This is because media is not sent via email, but rather is sent over the point-to-point connection. An email messaging program having playback capability is not part of Mattaway's system, and is in fact not needed within Mattaway's system. Mattaway does not, therefore, anticipate claim 12.

*Rejection of Claim 13 Under 35 USC 102*

Claim 13 is a dependent claim dependent from claim 12. As such, it is patentable for at least the reasons that have been described in accordance with both claim 12 and claim 8, the latter claim from which claim 12 depends. Claim 13 limits the playback capability of the email messaging program of claim 12 to "download[ing] the media associated with one of the messages received from the streaming media server over the network via the networking mechanism upon the user viewing the one of the messages received." Applicant submits that Mattaway does not disclose this added limitation of claim 13.

Mattaway does not disclose an email messaging program that downloads media from a streaming media server, as has been discussed in association with claim 2. The Examiner suggests that establishing real-time point-to-point communication of multimedia signals over the Internet anticipates claim 13. However, Mattaway only discloses the receiving of multimedia signals by a callee from a caller within such a real-time point-to-point communication. Mattaway does not disclose the downloading of media from a streaming media server by an email messaging program. There is no streaming media server disclosed by Mattaway. Downloading media from a streaming

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media server inherently implies previous storage of the media on the server, such as resulting from, for example, previous uploading by a composing user. By contrast, Mattaway's real-time point-to-point connection does not store the media at any point within the connection such that it can be considered that the receiving party "downloads" the media, whereas the invention of claim 13 is limited to such downloading from a streaming media server. Mattaway does not, therefore, anticipate claim 13.

*Rejection of Claims 15, 16, and 17 Under 35 USC 102*

Claims 15, 16, and 17 are dependent claims depending from claim 8. As such, they are patentable for at least the same reasons that have been described in relation to claim 8. Applicant therefore submits that these claims are also not anticipated by Mattaway.

*Rejection of Claim 18 Under 35 USC 102*

Claim 18 is an independent claim in which a method has "an email messaging program" "saving a message entered by a user," "recording media associated with the message," "uploading the media to a streaming media server over a network," and "sending the message over the network." That is, the email messaging program performs all of these functions. Applicant submits that Mattaway does not disclose a method having such an email messaging program, as to which claim 18 is limited.

Mattaway does not use an email messaging program to record media associated with a message that is sent to another user over a network, as has been discussed in association with claim 1. Furthermore, Mattaway does not use an email messaging program that uploads media to a streaming media server, as has been discussed in association with claim 2. Using an email address as an identifier to find a particular callee with which to set up a real-time point-to-point communication link, as in Mattaway's first embodiment, or using email to send a message that contains communication information to set up such a communication link, as in Mattaway's

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second embodiment, is not the utilization of an email messaging program to record media, as to which claim 18 is limited. This is the case even where media may be sent over the communication link in Mattaway, since the email messaging program is not performing this functionality. Furthermore, Mattaway's real-time point-to-point communication link is inconsistent with the usage of a streaming media server, since usage of a server implies media storage on the server for later – not real-time – download of the media, and Mattaway does not disclose or use such a streaming media server. Mattaway does not anticipate claim 18.

*Rejection of Claim 19 Under 35 USC 102*

Claim 19 is a dependent claim depending from claim 18. As such, it is patentable for at least the same reasons that have been described in relation to claim 18. Claim 19 also has the email messaging program of the method of claim 18 "receiving a second message over the network," and "in response to a user requesting the email messaging program to display the second message," "displaying the second message," "downloading second media associated with the message from the streaming media server over the network," and "playing back the second media." That is, the email messaging program performs all of these functions. Applicant submits that Mattaway does not disclose a method having such an email messaging program, as to which claim 19 is limited.

Mattaway does not use an email messaging program to playback media associated with a message that has been received over a network, as has been discussed in association with claim 1. Furthermore, Mattaway does not use an email messaging program that downloads media from a streaming media server, as has been discussed in association with claim 2. Using an email address as an identifier to locate a particular callee with which to set up a real-time point-to-point communication link, as in Mattaway's first embodiment, or using email to receive a message that contains communication information to set up such a communication link, as in Mattaway's second embodiment, is not the utilization of an email messaging program to playback media, as to

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which claim 19 is limited. This is the case even where media may be received over the communication link in Mattaway, since an email messaging program is not performing this functionality. Furthermore, Mattaway's real-time point-to-point communication link is inconsistent with the usage of a streaming media server, since usage of a server implies media storage on the server for later – not real-time – download of the media, and Mattaway does not disclose or use such a streaming media server. Mattaway does not anticipate claim 19.

*Rejection of Claim 22 Under 35 USC 102*

Claim 22 is an independent claim in which a computer-readable medium has instructions stored on the medium "for an email messaging program." It is, therefore, the *email messaging program* that includes the "means for composing a first message by a first user and for recording first media associated with the first message to send to a second user over a network" and the "means for viewing a second message received from the second user over the network by the first user, and for playing back send media associated with the second message." Applicant submits that Mattaway does not disclose an email messaging program that has such means.

Applicant notes that claim 22 is thus limited in its preamble to "an email messaging program" that has the two means elements. Applicant notes that the preamble to a claim is to be accorded "the import that the claim as a whole suggests for it." (MPEP, sec. 2111.02) More specifically, "[i]f the claim preamble, when read in the context of the entire claim, . . . 'is necessary to give life meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." (*Id.*)

The MPEP additionally cites *Kropa v. Robie*, 187 F.2d 150 (CCPA 1951), as providing an example that is particularly apt in the context of the preambles of claims 1, 2, 4, 6, 9, and 10.

A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims . . . . The court stated that "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as

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an ‘abrasive article.’ . . .” Therefore, the preamble served to further define the structure of the article produced.

(MPEP, sec. 2111.02) Similarly, it is only by the phrase “an email messaging program” that it can be known that the subject matter defined by claim 22 is comprised as a computer-readable medium having instructions stored thereon for “an email messaging program.”

Mattaway, however, does not disclose an email messaging program that can compose an email message and record media associated with the message, and that can receive an email message and playback media associated with the message, as has been discussed in association with claim 1. Mattaway’s first embodiment uses email addresses, not email messages, to uniquely identify users with whom real-time, point-to-point communications can be arranged. An email messaging program that can record media associated with an email message, or playback media associated with an email message, is not disclosed by Mattaway. Mattaway’s second embodiment only utilizes email to exchange communication information within email messages so that real-time, point-to-point communications can be arranged. The media is not recorded or played back by an email messaging program in Mattaway. Mattaway, therefore, does not anticipate claim 22.

#### *Rejection of Claim 23 Under 35 USC 102*

Claim 23 is a dependent claim depending from claim 22. As such, it is patentable for at least the reasons that have been described in accordance with claim 22. Claim 23 adds further limitations to the means elements of the email messaging program of claim 22. The means for composing and for recording further “uploads the first media to a streaming media server communicatively coupled to the network over the network upon the first message being sent to the second user over the network.” The means for viewing and for playing back further “downloads the second media from the streaming media server over the network upon the first user viewing the second message.” Applicant submits that Mattaway does not disclose these added limitations of claim 23.

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Mattaway does not employ an email messaging program that uploads media to or downloads media from a streaming media server, as has been discussed in association with claim 2. Mattaway only discloses the sending of multimedia from a caller to a callee directly through a real-time, point-to-point connection. There is no media streaming server disclosed by Mattaway. For instance, the inherent implied storage of media on such a server after uploading of the media thereto for later downloading of the media therefrom is inconsistent with, and contradicted by, Mattaway's use of a point-to-point connection in which real-time communication is afforded. Mattaway does not, therefore, anticipate claim 23.

#### Claim Rejections Under 35 USC 103

Claims 3, 11, 14, 20, 21, and 24 have been rejected under 35 USC 103(a) as being unpatentable over Mattaway (6,131,121) in view of Eyal (6,389,467). Applicant respectfully submits that Mattaway in view of Eyal does not render the invention of claims 3, 11, 14, 20, 21, and 24 obvious. Applicant submits first that Mattaway is not properly combinable with Eyal, such that a *prima facie* case of obviousness has not been made, and second that Mattaway in view of Eyal do not disclose all the limitations of claims 3, 11, 14, 20, 21, and 24.

#### *Mattaway Is not Properly Combinable with Eyal*

Applicant first avers that Mattaway is not properly combinable with Eyal, such that a *prima facie* case of obviousness has not been established. Applicant asserts that combining Eyal with Mattaway destroys the intended functionality of Mattaway. Applicant also asserts that Eyal teaches away from Mattaway. Applicant further asserts that Eyal and Mattaway disclose prior art that is non-analogous to one another, such that they are not combinable. Applicant finally discloses that the teachings of Eyal are not properly combinable with Mattaway, as specifically relied upon by the Examiner. Applicant now discusses in detail each of these four independent reasons as to why Mattaway is not properly combinable with Eyal.

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First, combining Eyal with Mattaway destroys the intended functionality of Mattaway. As has been indicated in conjunction with the claim rejections under 35 USC 102, Mattaway discloses establishing a real-time, point-to-point communications link between a caller and a callee. By comparison, Eyal discloses the utilization of network addresses, such as Universal Resource Locators (URL's) that are associated with media resources stored on servers. (Abstract, col. 12, ll. 28-32) Combining Mattaway with Eyal so that, for instance, the email messages of Mattaway that contain the communication information to establish the real-time point-to-point communications also contain URL's of media destroys the intended purpose of Mattaway, however. Mattaway allows for media subject matter itself to be communicated within the real-time point-to-point communications links between callers and callees. If Mattaway were modified so that the email messages that convey the communication information needed to establish the links also contain URL's of media, then there would be no point of having the real-time communications links in the first place. A caller would not have to send the media over a real-time communication link, as is specifically contemplated by Mattaway, but rather would just have to send the URL of the media in the initial email to the callee, such that no real-time communication link would even have to be established. Therefore, combining Eyal with Mattaway destroys the intended functionality of Mattaway, in that the combination renders meaningless the use of real-time point-to-point communication links between callers and callees.

Second, Eyal teaches away from Mattaway. Eyal teaches communicating the URL's of media so that, for instance, a caller does not have to transmit all of the media information directly to the callee, but rather only has to transmit the URL of the media to the callee, such that the callee subsequently downloads the media at the indicated URL. In this sense, Eyal teaches away from Mattaway. This is because Mattaway teaches transmitting *all* of the media information directly from the caller to the callee within a real-time, direct communications link between the caller and the callee, such as the transmission of an entire media file, as opposed to the transmission of a URL identifying where the file is located. The manner by which Eyal teaches

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media information transfer thus teaches away from the manner by which Mattaway teaches media information transfer. The former teaches an indirect media transfer, by transferring only the URL of the media from the caller to the callee, whereas the latter teaches a direct media transfer, by transferring all of the media itself directly from the caller to the callee.

Third, Eyal and Mattaway are non-analogous to one another. Mattaway relates to the personal transfer of information from a caller party to a callee party through a direct, real-time communications link between the two parties. By comparison, Eyal relates to the enabling of “a continuous streaming media playback from *a distribution of sites* available over a network such as the Internet.” (Abstract) That is, Eyal does not relate to the transfer of information between two end users. Rather, Eyal relates to a *single end user* being able to download information available throughout the Internet. The personal, direct real-time communications nature between two parties within Mattaway is not present in Eyal. For instance, a user in Eyal is able to generate play lists of different media located in different places on the Internet (FIG. 12, blocks 1040 and 1042), and is able to rate the different media found for the benefit of others (FIG. 12, block 1030). In the context of Mattaway, however, such capabilities make no sense. The communication between a first end user and a second end user does not involve media that is to be rated by the second end user, because the communication is directly between the two end users. That is, it is not as if a third end user can also communicate with the first end user at any desired time and receive the same media that was received by the second end user. Eyal and Mattaway are thus non-analogous and non-combinable.

Fourth, Eyal is not properly combinable with Mattaway, insofar as specifically relied upon by the Examiner. Mattaway may use an email messaging component in one embodiment to convey communications information between a caller and a callee so that a direct point-to-point communications link can be established between the caller and the callee. However, Eyal seemingly does not disclose an email messaging component. The Examiner states that Eyal discloses an email messaging program in its Abstract, in FIG. 12, and at column 37, lines 4-61,

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among other places. Applicant has thoroughly read and reviewed Eyal, however, but cannot find anywhere that Eyal specifically discloses an email messaging program. The lack of an email messaging program taught by Eyal means that Eyal does not have an email messaging program to combine with that of Mattaway. Combining a particular type of program having one set of features with the same type of program having a different set of features may be proper, but this is not the situation with combining Mattaway and Eyal. Rather, combining Mattaway and Eyal is tantamount to combining a particular type of program having one set of features with *a different type of program* having a different set of features, which is improper.

#### *Rejection of Claim 3 Under 35 USC 103*

Claim 3 is a dependent claim depending from independent claim 1. Therefore, claim 3 is patentable for at least the same reasons that claim 1 is. Claim 3 specifically limits the first email messaging program of claim 1 as “attach[ing] the media as an attachment to the message upon the message being sent to the receiving user over the network.” Furthermore, claim 3 specifically limits the second email messaging program of claim 1 as “receiv[ing] the media as the attachment to the message over the network.” Applicant submits that Mattaway in view of Eyal, even if properly combinable, do not render claim 3 obvious.

Mattaway in view of Eyal at best teach the attachment of a network address of media to an email message from a composing user to a receiving user, and not the attachment of the media itself to the email message. The Examiner states that Eyal discloses the “attaching in an email message the URL of the selected media resource.” (Office Action, p. 7, para. 5) However, although Applicant disagrees that Eyal discloses the utilization of email, attaching the URL of a media resource to an email message is in any case not the same thing as attaching the media resource itself to the email message. For example, a user may have particular media, such as, for instance, an audio file in .WAV format, which may also be located at a web site and identified by a particular URL. The invention of claim 3 is limited to the scenario in which such media – that is,

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the audio file itself – is attached to an email message. By comparison, Mattaway in view of Eyal at best may teach the attachment of the particular *URL* of the media – and not the audio file itself – to the email message. Mattaway in view of Eyal, therefore, do not render claim 3 obvious.

*Rejection of Claims 11 and 14 Under 35 USC 103*

Claims 11 and 14 are dependent claims ultimately depending from independent claim 8. Therefore, claims 11 and 14 are patentable for at least the same reasons that claim 8 is. Claim 11 specifically limits the composing capability of the email messaging program as “attach[ing] the media as an attachment to the message upon the message being sent to the other user over the network.” Claim 14 specifically limits the playback capability of the email messaging program as “receiv[ing] the media associated with one of the messages as an attachment to the one of the messages received over the network.” Applicant submits that Mattaway in view of Eyal, even if properly combinable, do not render claims 11 and 14 obvious. As has been discussed in association with claim 3, Mattaway in view of Eyal at best teach the attachment of a network address of media, such as a *URL*, to an email message from a composing user to a receiving user. Mattaway in view of Eyal do not teach the attachment of the media itself to the email message, as to which claims 11 and 14 are limited.

*Rejection of Claims 20 and 21 Under 35 USC 103*

Claim 20 is an independent claim from which claim 21 depends. Claim 20 is a method in which an “an email messaging program” performs the following functionality: “saving a message entered by a user,” “recording media associated with the message by the email messaging program,” “attaching the media to the message”, and “sending the message over a network”. Claim 21 is a method in which the email messaging program of claim 20 further performs the following functionality: “receiving a second message having attached thereto second media over the network”; and, “in response to the user requesting the email messaging program to display the

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second message," "displaying the second message" and "playing back the second media by the email messaging program." The email messaging program thus performs all of these functions, in which media is attached to an email message. Applicant submits that, even if properly combinable, Mattaway in view of Eyal do not disclose a method having such an email messaging program, as to which claims 20 and 21 are limited.

Mattaway in view of Eyal does not use an email messaging program to record and play back media associated with a message, as has been discussed in association with rejection of claims 1, 18, and 19 under 35 USC 102. Furthermore, Mattaway in view of Eyal does not disclose the attachment of media itself to an email message. As has been discussed in association with claim 3, Mattaway in view of Eyal at best teach the attachment of a network address of media, such as a URL, to an email messaging from a composing user to a receiving user. Mattaway in view of Eyal, even if properly combinable, do not render claims 20 and 21 obvious and non-patentable.

#### *Rejection of Claim 24 Under 35 USC 103*

Claim 24 is a dependent claim depending from independent claim 22. Therefore, claim 24 is patentable for at least the same reasons that claim 22 is. Claim 24 specifically limits the means for composing and for recording of the email messaging program of claim 22 as "attach[ing] the first media as an attachment to the first message upon the first message being sent to the second user over the network." Claim 24 also specifically limits the means for viewing and for playing back of the email messaging program of claim 22 as "receiv[ing] the second media as an attachment to the second message over the network." Applicant submits that Mattaway in view of Eyal, even if properly combinable, do not render claim 24 obvious. As has been discussed in association with claim 3, Mattaway in view of Eyal at best teach the attachment of a network address of media, such as a URL, to an email message from a composing user to a receiving user.

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Mattaway in view of Eyal do not teach the attachment of the media itself to the email message, as to which claim 24 is limited.

**Conclusion**

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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